

## **REMARKS/ARGUMENTS**

### **1. Summary of the Office Action**

Claims 1-18 and 24-38 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Publication No. 2001/0018349 (hereinafter Kinnunen) in view of U.S. Patent No. 6,751,702 (hereinafter Hsieh).

Claims 19-23 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hsieh in view of ‘Official Notice’.

### **2. Response to 35 U.S.C. § 103 Rejections**

The pending claims have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kinnunen in view of Hsieh. As discussed below, however, this combination of teachings is improper being based on hindsight reconstruction. Even if the combination were to be made, the present claims would still contain features neither taught nor suggested by the references. Therefore, the present claims are patentable over these references whether considered alone or in combination with one another.

To establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The present claims are patentable over Kinnunen in view of Hsieh as none of the cited references teaches or suggests the presently claimed feature of “responsive to the human operator selecting an option available on the graphical user interface, issuing a series of one or more generic Application Program Interface (API) calls representative of the option to the new

network device wherein said API calls cause execution of interface software preloaded on the new network device and contain instructions specific to the new network device for implementing the API calls; and executing the interface software preloaded on the new device to perform device specific equivalents to the series of one or more generic API calls” (Claim 1)

Kinnunen presents a system for providing location dependent services to a plurality of mobile terminals within a coverage area. The system receives ‘from a plurality of sources, location information indicating the locations of mobile terminals and tracks them so that their presence in particular service deployment areas can be determined. The services receive meta-information classifying the location information and use this meta-information to determine whether the source of the location information is reliable enough for the service to be provided. If it is reliable enough, the service is provided to the mobile terminal” (Abstract). However, as the Office Action concedes, Kinnunen is silent to the presently claimed features as specified above. Indeed, Kinnunen is only concerned with identifying the location of mobile terminals so as to match the terminals with the service providers within the coverage area. This is fundamentally different from the present claims which include discovering and configuring a new network device through API calls. There is no motivation or need for Kinnunen to teach the presently claimed features as Kinnunen is not at all concerned with network devices. Therefore, the present claims are not anticipated by Kinnunen.

Even if the references are combined, the additional teachings of Hsieh fail to correct the deficiencies of Kinnunen. Hsieh claims a method for “allocating storage to a host within a central data storage device having at least one switch disposed therebetween, said method comprising the steps of: (a) informing the central storage device that the host is authorized to access a predetermined storage area, said predetermined storage area being a subset of said unallocated storage space; (b) creating a path through the switch between said central data storage device and said host; and (c) informing the host that said predetermined storage area has been allocated thereto, wherein at least one of steps (a)-(c) is performed using information extracted from a data model associated with said central storage device” (Hsieh, Claim 1). In particular, the Office Action relies on Col.1, lines 30-60, Table 1 and Col.8, line 42 – Col.9, line 35 to teach the presently claimed feature as specified above. However, the assertion is incorrect and the cited references fail to teach or even suggest the presently claimed feature. Col.1, lines 30-60 of Hsieh only provides an elaboration of Figure 3 which includes a central storage device connected via a

plurality of optical links to a switching matrix. On the other hand, Table 1 and Col. 8, line 42 – Col.9, line 35 present a variable set of device entities which “can be used in relating information contained within the storage device to various ports and zones contained on the switching unit” (Hsieh, Col. 8, lines 30-34). Indeed, the cited reference only presents a data model containing the variable set of device entities for allocating storage to a device entity within a central data storage device. Nowhere is there any mention of the presently claimed feature of “responsive to the human operator selecting an option available on the graphical user interface, issuing a series of one or more generic Application Program Interface (API) calls representative of the option to the new network device wherein said API calls cause execution of interface software preloaded on the new network device and contain instructions specific to the new network device for implementing the API calls; and executing the interface software preloaded on the new device to perform device specific equivalents to the series of one or more generic API calls” (Claim 1). Clearly, Hsieh fails to cure the deficiencies of Kinnunen. Therefore, the present claims are patentable over the cited references.

In addition, there has been no showing of the required motivation for the suggested combination, nor has there been any showing of a reasonable expectation of success. The Office Action suggests that it would have been obvious to one of ordinary skill in the art to combine the teachings of these references. However, this conclusion finds no support in the references. Indeed the Office Action cites no motivation for such a combination, other than a general desire to improve the configuration capability for Kinnunen by allowing various storage devices on the network to be configured in a centralized location (Office Action, Page 4). This rote invocation of a general desire to make existing technologies better is an insufficient basis for reaching a conclusion of obviousness. Instead, what is needed is an actual showing of motivation to make the desired combination.

In this case, each of the references themselves provides what appears to be a complete solution for traffic management. Neither of the references suggests that additional steps are needed to improve the techniques disclosed herein. For example, Kinnunen teaches detecting location dependent services within a coverage area. For his part, Hsieh presents a method for automated provisioning of central storage devices using a data model. Nothing in these disclosures would suggest that any combination of these processes is desirable. Consequently, there exists no motivation for the recited combination.

Rather than making a proper *prima facie* case of obviousness, it appears that the teachings of the present application have been used as a blueprint to gather together and assemble various components of the prior art in the manner contemplated by the present applicant. This is a classic example of the use of hindsight reconstruction, and cannot properly be used as grounds for rejecting the present claims. Indeed, the U.S. Court of Appeals for the Federal Circuit has rejected such applications of hindsight by specifically indicating that when an obviousness rejection is made based upon a combination of references, an examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (emphasis added). Merely indicating, as in the present Office Action, that the claimed invention would be obvious to one of ordinary skill in the art based on the combination of the references is inadequate.

As demonstrated above, the present Office Action deconstructs the subject matter of the claims into its constituent components, states where each such component may be found in one of the cited references, and then concludes that it would have been obvious to combine the references to arrive at the claimed invention. This bare bones analysis is not sufficient to support the present rejections. The burden is on the Examiner to show *why* one would be so motivated as to come up with the combination. *Rouffet* at 1357-1358 ("If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields the [Patent Office] could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.") Accordingly, the present rejections should be removed.

**3. Conclusion**

Having tendered the above remarks and amended the claims as indicated herein, the Applicant respectfully submits that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact Jaina Chua at (408) 947-8200.

Respectfully submitted,

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